

Please add the following new claims:

30. A method for inducing the formation and/or maintenance of chondrocyte and/or cartilaginous tissue said method comprising the administration of a composition of claim 20.

31. A method for treating rheumatoid arthritis said method comprising administering a protein of claim 18 to a patient in need of same.

32. A method for treating osteoarthritis said method comprising administering a protein of claim 18 to a patient in need of same.

REMARKS

As pointed out to the Examiner during a phone conversation, there are typographical errors in the office action, however in most cases Applicants' Attorney was able to decipher the Examiner's intention and discussed with the Examiner those errors which were ambiguous. Claim 20 has been amended, as further discussed below, and new claims 30-33 (dependent on claims 20 and 18, respectively) have been added. Basis for claims 30-33 appears in the specification for example on page 19 through 22. No new matter has been added, and no new issues are raised by the claims.

The claims as now presented are reproduced in Appendix A attached hereto for the Examiner's convenience.

Rejection Under Section 112, First Paragraph

Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, for a perceived lack of enablement. Applicants do not acquiesce in the rejection, but have amended the claims in an effort

to further advance prosecution. Claim 20 as amended is directed to a composition for the formation and/or maintenance of chondrocyte and/or cartilaginous tissue. Applicants reserve the right to pursue previously claimed and other subject matter disclosed in the application in one or more continuing applications. Applicants submit that amended claim 20 is enabled finding support, for example, at page 19 of the specification, wherein it is disclosed that human SDF-5 has application in the induction, formation, growth, differentiation, proliferation and/or maintenance and healing of cells and tissues such as chondrocyte and/or cartilaginous tissue. Such a preparation employing human SDF-5 protein may have prophylactic use in treatment of rheumatoid arthritis and osteoarthritis and traumatic injury to cartilage. The preparation and formulation of therapeutic compositions comprising human SDF-5 is described on pages 21 and 22, and the dosage regimen for administration of SDF-5 is described on page 22. Moreover, Example 3 of the specification describes the Rosen-modified Sampath-Reddi assay, which provides an *in vivo* assay for evaluating bone, cartilage, and/or other connective tissue activity of SDF-5.

Claim 28 is rejected for lack of enablement for the reasons recited with respect to claim 20. Applicants do not acquiesce in the rejection, but in an effort to further advance prosecution have amended claim 28 to depend from amended claim 20 thereby overcoming the rejection.

Provisional Double-Patenting Rejection

Claims 18-20, 22, 23 and 25 are provisionally rejected under the judicially created doctrine of double patenting over claims 18-20, 22, 23 and 25 of copending application No. 08/848,439. Applicants note that this is a provisional rejection and upon allowance of conflicting claims in the present application Applicants will cancel claims drawn to the proteins and compositions thereof in the copending application which is currently under suspension. Claim 19 is a product-by-

process claim and therefore Applicants will maintain this claim in one of the pending application and upon allowance cancel the conflicting claim.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request issuance of pending claims 18-20, 22-23, 25 and 28-32. Should the Examiner believe that a telephonic interview would assist in clarifying any remaining issues, or to otherwise expedite prosecution Applicants respectfully invite the Examiner to call the undersigned attorney at the telephone number provided below.

If any fee is due with regard to this paper, Applicants hereby authorize payment of such fee from Deposit Account No. 07-1060.

Respectfully submitted,

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OK to call
there - she
works at home*

Appendix A

18. A purified human SDF-5 polypeptide comprising an amino acid sequence of SEQ ID NO: 2 or SEQ ID NO: 3.

19. A purified human SDF-5 protein produced by the steps of
(a) culturing a cell transformed with a DNA molecule comprising the nucleotide sequence from nucleotide #316 to #1143 as shown in SEQ ID NO:1; and
(b) recovering and purifying from said culture medium a protein comprising the amino acid sequence from amino acid #21 to amino acid #295 as shown in SEQ ID NO:2.

20. A composition for the formation and/or maintenance of chondrocyte and/or cartilaginous tissue in a patient in need of same comprising a therapeutic amount of the human SDF-5 protein according to claim 19.

22. A purified human SDF-5 protein comprising the amino acid sequence from amino acid #1 to #295 of SEQ ID NO:2.

23. A purified human SDF-5 protein comprising the amino acid sequence from amino acid #1 to #275 of SEQ ID NO:3.

25. A purified human SDF-5 protein having a molecular weight of about 30 to about 35 kDa said protein comprising the amino acid sequence of SEQ ID NO:3 and having the ability to regulate the transcription of one or more genes.

28. The pharmaceutical composition of claim 20 further comprising a pharmaceutically acceptable carrier.

29. A purified human SDF-5 polypeptide comprising an amino acid sequence selected from the group consisting of:
(a) amino acids 1, 18, 19, 20, 21, 22, 23, 24 or 25 to 295 of SEQ ID NO: 2; and
(b) amino acids 1 to 275 of SEQ ID NO:3.

30. A method for inducing the formation and/or maintenance of chondrocyte and/or cartilaginous tissue said method comprising the administration of a composition of claim 20.

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OCT 28 1999

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October 27, 1999
ISSN 08/949,904
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32. A method for treating osteoarthritis said method comprising administering a protein of claim 18 to a patient in need of same.